

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

REQUEST FOR WITHDRAWAL OF THE FINALITY OF THE OFFICIAL ACTION

UNDER MPEP 706.07.

Initially, it is respectfully suggested that this rejection was prematurely made final, and that the finality of this Official Action should be withdrawn. Finality of this official action was improper based on the criteria set forth in MPEP 706.07(a).

Specifically, in the last Official Action, dated September 5, 2003, the subject matter of certain claims were not changed. Claims 93, 94, 96, 98, 100 and 102 were also each amended into independent form without change. Therefore, each of these claims represented originally claimed subject matter, not amended subject matter. Moreover, claims 105 and 116 are entirely original, that is to say, they were not amended at all, and still correspond to the original claims.

The current Official Action, paper number 17, cites two entirely new references, specifically, Schneck and Rhoads. However, the rejection states in item 4 that "Applicant's amendment necessitated the new ground of rejection...", and makes the rejection final. This contention is respectfully traversed. Certain claims, noted above, were not amended. Therefore, the amendment did not require a new search, or at least not for these claims. Therefore, the claim amendments did not necessitate a new ground of rejection, at least for these claims.

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

Moreover, MPEP 706.07a, and MPEP page 700-57 right column, last paragraph is precisely on point. Specifically, this section states that "any second or subsequent action on the merits in any application... will not be made final if it includes a rejection on newly cited art... of any claim not amended by applicant... in spite of the fact that other claims may have been amended to require newly cited art" emphasis added. This section is exactly on point. Claims 93, 94, 96 and 98 were amended into independent form. No substantive changes to these claims were made. Accordingly, the rejection was improperly made final per MPEP 706.07, and withdrawal of the finality is respectfully requested.

Of course, this request becomes moot should the Examiner find the arguments below to be persuasive.

REJECTIONS UNDER 35 U.S.C. 103

Claims 85-90, 93-107, 116-119 and 121-124 stand rejected under 35 U.S.C. 103 as allegedly being unpatentable over Schneck in view of Rhoads. Claims 93-95 are amended to obviate the rejections thereto. The rejection of the remaining claims is respectfully traversed, and for reasons set forth herein, it is respectfully suggested that the rejection does not meet the Patent Office's burden of providing a prima facie showing of unpatentability.

In discussing claim 85, the rejection alleges that Rhoads shows a network storing images representing pages of a book and sending one of those images to a remote node. It is respectfully suggested that Rhoads does not in fact show this, but rather shows and suggests working with only a single image from the book.

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

Rhoads does refer to marketing of a book. The discussion of book operations begins at column 22 line 35. A JPEG of the cover or artwork representing the book can be used. Column 23 describes that when the user selects the book, the user may receive the JPEG image file of the book cover, see column 23 line 15. Only one single JPEG for each book: the cover: is available for each book. To the extent Rhoads may have multiple images, they are multiple images, one per book, for multiple books. Therefore, Rhoads teaches nothing about the claimed feature of "storing a plurality of images representing pages of the book... sending one of said images to a remote node" (emphasis added). Rhoads teaches only a single book page, here the cover, being stored for each book. He teaches nothing about sending one of multiple images to a remote node.

The rejection admits that Rhoads does not teach determining if the request for pages is over a threshold and sending the pages only if a threshold is not exceeded. Naturally, Rhoads does not teach this, since Rhoads allows only one single page to be sent; there is no sense in counting the pages when you know that only one page can be sent.

From this point of view, it would not be apparent to one having ordinary skill in the art to combine Rhoads with any kind of page counting mechanism; since Rhoads only teaches sending a single page. Therefore, there would be no incentive to combine the references for this reason.

In any case, even if the references WERE combined, Schneck teaches nothing about page counts. Schneck teaches a system that controls access to copying of a digital element. The access control mechanism can use cryptographic techniques to control whether a file can be copied or not. The rejection refers to column 2 lines 46-67

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

of Schneck. However, this cited portion just teaches that digital files can be freely copied if no copy protection is attached. Nowhere is there any teaching or suggestion of counting a number of pages of books which have been electronically viewed, and allowing an additional page to be displayed only if the page count does not exceed a threshold, as required by claim 85. Therefore, claim 85 should be allowable for these reasons; nothing in the hypothetical combination of Rhoads in view of Schneck in any way teaches or suggests these features.

Claim 86 further adds the limitations that certain images count towards the threshold and the counter is incremented only when the requested image counts toward the threshold. The rejection relies on column 7 lines 1-43 of Rhoads. This cited section refers to the data fields that are included in an audio file and has nothing to do with book reading. The settings in the audio file of Rhoads may determine how long the file can be listened to, or how many times the file can be listened to. This has nothing to do with a number of pages. Moreover, Rhoads teaches nothing about applying this system to a book, which is a very different kind of medium than music. A person listening to music will typically want to listen to the song over and over again, while a book reader would only want to read the book once in a typical scenario. The systems are entirely different, and not analogous, in this sense.

Claims 93-95 are canceled to obviate the rejections thereto.

In rejecting claims 96-107, 116-119, and 121-124, the rejection simply states that these are similar to the previous claims. However, this is respectfully traversed.

Claim 96 defines displaying a screen tip indicating what the reaction will be to a specified operation in the context of viewing the book contents. Nothing in the cited

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

prior art in anyway teaches or suggests such a screen tip, nor does the rejection even allege that this is possible.

Claim 97 specifies opening the book to see its inside. This is not possible with the hypothetical combination of Rhoads in view of Schneck. As discussed above, this hypothetical combination would use the picture-of-the-cover-only approach of Rhoads. It would not be possible to open the book using this system; as there is no teaching or suggestion of multiple images which could be used in this way. Rhoads in view of Schneck would only have a single picture, of the book cover. It would not be possible to open the book, as claimed, since, there would be no images of the book's inside.

Claim 98 specifies that each of the images have a graded resolution; with readable resolution for the readable parts and the different resolution for the non-readable parts. There is no teaching or suggestion of this feature in either Schneck or Rhoades, nor does the rejection even allege that there is. Therefore, this claim should be additionally allowable for these reasons.

Claim 99 similarly specifies the readable parts being in text form, and the different parts being in image form; again; this is not taught or suggested by the cited prior art. Therefore, this claim should be additionally allowable for these reasons.

Claim 100 specifies displaying keys which enable moving the position of viewing which again is completely different than anything that is taught by the cited prior art. Therefore, this claim should be additionally allowable for these reasons.

Claim 102 specifies limiting the number of pages which can be read. The advantages and distinctions of this subject matter have been extensively discussed above with respect to claim 85. Therefore, this claim should be additionally allowable for these reasons.

Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

Claim 105 similarly recites determining if more than a specified number of pages have been requested and sending the page only if the specified number of pages does not exceed a threshold. Again, this is in no way taught or suggested by the cited prior art, and should be completely allowable thereover.

Claim 106 specifies that only certain kinds of pages have limits, again allowable for reasons discussed above.

Claim 107 specifies allowing the user to read beyond the specified number of pages after paying a fee, again allowable over the cited prior art which does not suggest anything about this.

Claim 116 specifies limiting the pages that can be returned over the network, and again should be allowable for reasons discussed above.

Claim 121 similarly specifies limiting a number of pages that can be displayed, and again this claim is allowable for reasons discussed above since neither of the references, nor the combination thereof, teaches or suggests this feature. The dependent claims should be additionally allowable. Claims 122 and 123 specify respectively providing additional information which again is nowhere taught or suggested by the cited prior art.

In view of the above amendments and remarks, therefore, all of the claims should be in condition for allowance. A formal notice to that effect is respectfully solicited.

Should the Examiner have any issues remaining after considering this amendment, the Examiner is respectfully encouraged to call the undersigned at the below telephone number, in an attempt to most expeditiously resolve these issues.

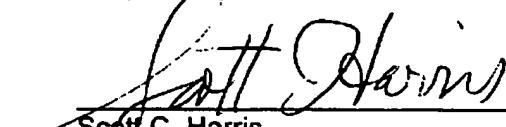
Attorney's Docket No.: Touch and Feel
Serial No. 09/505,646

If there are any other charges, or any credits, please apply them to Deposit

Account No. 50-1387.

Respectfully submitted,

Date: 1/19/04



Scott C. Harris
Reg. No. 32,030

Customer No. 23844
Scott C. Harris, Esq.
P.O. Box 927649
San Diego, CA 92192
Telephone: (619) 823-7778
Facsimile: (858) 678-5082